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|--|---------------------------|---------------------------------------|---------------------------------------|--------------------------|
| APPLICATION NO.<br>09/782,934  | FILING DATE<br>02/13/2001 | FIRST NAMED INVENTOR<br>Natwar Modani | ATTORNEY DOCKET NO.<br>JP920000227US1 | CONFIRMATION NO.<br>1660 |
| 7590<br>12/01/2004<br>MCGINN & GIBBS, PLLC<br>2568-A RIVA ROAD<br>SUITE 304<br>ANNAPOLIS, MD 21401 |                           |                                       | EXAMINER<br>LE, KHANH H               |                          |
|  |                           |                                       | ART UNIT<br>3622                      | PAPER NUMBER             |

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/782,934

Applicant(s)

MODANI ET AL.

Examiner

Khanh H. Le

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### Detailed Action

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1. This Office Action is in response to the Amendment and Response dated August 20, 2004. Claims 1-13 are cancelled. New claims 14-33 are added and now pending. Claims 14, 24, and 26 are independent. Submission of formal drawings is acknowledged.

#### Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 14-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 14 only mentions "issuing an electronic coupon" which is a trivial use of technology. As explained in MPEP 2106 (IV) (B)(2) (b), and MPEP 2106 (IV) (B)(2) (b) (i), some computer-related claim processes do not meet the "practical application within the technological arts" test required under 35 USC § 101. Mere steps such as "transmitting electrical signals representing the results of calculations" or "displaying a calculation as a gray code" have been found to have failed this test. Here "issuing an electronic coupon", without more recitation of use of technology in other steps of the claim, is comparable, to the transmitting of mere electrical signals or the mere displaying of codes, as cited in the above two failing examples. It is recommended that claim 14 be amended to recite at least using a computer in the step of determining the authenticity of the coupon to overcome this rejection.

Claims 15-23 are rejected under this section because they are dependent on claim 14.

Claims 24-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed coupon made up of data fields, is non-functional

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descriptive material, and not a process, machine, manufacture or composition of matter, and therefore fails the 35 USC § 101 test. See MPEP 2106 (IV) (B)(1) (b).

### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 14-23, and 26-33 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.**

Applicants disclose that the main purpose of the invention is to discourage cross-coupons. (Specifications at page 2, 1<sup>st</sup> full paragraph; Amendment p. 10, 1<sup>st</sup> full paragraph). To this end the intermediary "authentication party" CCIA charges the retailer a fee which it passes to the issuing manufacturer (Specifications at page 7, 1<sup>st</sup> full paragraph). The fee can be sought and obtained from the issuing party only by a non-competing party who has obtained a validity certificate from the CCIA (Specifications at page 7, 3rd full paragraph). Thus the fact that the party seeking reimbursement and obtaining it is a non-competing party is an essential part of the invention. Thus the obtaining of the certificate of validity and the determination of whether the honoring party is a non-competing party are essential steps that cannot be omitted without violating 35 U.S.C. 112, second paragraph.

Further in claim 14, it is claimed the redemption party is seeking reimbursement but the omitted step is to obtain reimbursement. Without it, the object of the invention has not been realized.

Appropriate corrections are required.

Claims 15-23 are rejected under this section because they are dependent on claim 14.

Claim 26 is rejected under this section for the same reasons as claim 14.

Claims 27-33 are rejected under this section because they are dependent on claim 26.

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**Claim Rejections - 35 USC § 102**

6. Previous rejections of Claims 1-3, 13 under 35 U.S.C. 102(e) as being anticipated by Palmer et al., US 6505,773 B1 are withdrawn as moot.

**Claim Rejections - 35 USC § 103**

7. Previous rejections of Claims 4-12 under 35 U.S.C. 103(a) as being unpatentable over Palmer in view of Scroggie et al., US 6,185,541 B1, are withdrawn as moot.

**Allowable Subject Matter**

8. Claims 14-23, and 26-33 are considered to contain allowable subject matter.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements ( as indicated above) or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

**Reasons for allowance**

9. The following is an examiner's statement of reasons for allowance:

Whereas fees charging by an intermediary e-coupons authentication party is known, the combination of the following steps (**in bold**) distinguish the invention from the prior art:

Claim 14: A method for honoring electronic coupons utilizing computing equipment, said method comprising:

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an issuing party issuing an electronic coupon to a customer;

said customer presenting said coupon for redemption to a redemption party;

said redemption party transmitting said coupon to an authentication party for authentication, **said authentication party being different than said issuing party;**

said authentication party determining whether said coupon is authentic;

said authentication party charging said redemption party a fee upon determination that said coupon is authentic;

**said authentication party passing said fee to said issuing party;**

said redemption party honoring said coupon from said customer, and

upon said honoring, **said redemption party seeking reimbursement of said fee from said issuing party.**

Claims 15-23 are allowable because they are dependent on claim 14.

Claim 26 is allowable for the same reasons as claim 14.

Claims 27-33 are allowable because they are dependent on claim 26.

10. The closest US patent prior art reference is:

Palmer et al., US 6505,773 B1 discloses an online coupon issuing and redemption system and method that receives requests for coupons from consumers, presents advertisements, and issues coupons to consumers electronically. The coupons are digitally signed in order to prevent fraud. In order to prevent further fraudulent tampering of coupons, the redemption station includes a tamper-protected coprocessor for performing operations on the coupons. The system further includes capability for the redemption station to link to an issuing station for electronic reimbursements.

However, Palmer, alone or in combination with any other prior art reference, fails to teach or suggest a third party authentication and validation component which authenticates and validates the redeemed electronic coupons and is not subject to the deficiencies of a cross-coupon honoring system by charging the redemption party, passing the fee to the issuing party

and allowing the redemption party to seek and obtain reimbursement of the fee from the issuing party.

11. The closest foreign patent prior art is WO 200120527 to Beach et al. which discloses a shopping assistance program whereby coupons are verified at point of sales to conform to coupon criteria and authorized deposits are made to users' accounts.

However, Beach et al., alone or in combination with any other prior art reference, fails to teach or suggest a third party authentication and validation component which authenticates and validates the redeemed electronic coupons and is not subject to the deficiencies of a cross-coupon honoring system by charging the redemption party, passing the fee to the issuing party and allowing the redemption party to seek and obtain reimbursement of the fee from the issuing party.

12. The closest non-patent prior art is :

"Coupon Chaos: Plea to Stores", Super Marketing, n1014, p8(2), Mar 20, 1992, Dialog File 148, Record # 05896417. It discloses cross and misredemption of coupons.

However, Coupon Chaos, alone or in combination with any other prior art reference, fails to teach or suggest a third party authentication and validation component which authenticates and validates the redeemed electronic coupons and is not subject to the deficiencies of a cross-coupon honoring system by charging the redemption party, passing the fee to the issuing party and allowing the redemption party to seek and obtain reimbursement of the fee from the issuing party.

### Conclusion

13. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

November 12, 2004

KHL

  
JAMES W. MYHRE  
PRIMARY EXAMINER